REMARKS

Claims 1 and 3-14 are the claims currently pending in the present Application.

Rejection of Claims 1 and 3-14 under 35 U.S.C. §103

Claims 1 and 3-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schena et al., U.S. Patent No. 6,546,418, in view of Dougherty et al., U.S. Patent No. 6,587,859. This rejection is traversed.

As set forth in independent claims 1 and 6, the features of the present invention include "reading an image on said printed publication and storing said image in a memory", "extracting said contents locating information from said image" and "displaying said image stored in said memory as a bookmark image." Accordingly, such features enable a user to enjoy the convenience of using the scanned image as a bookmark. This achieves an object of the present invention by facilitating users to correlate a given article or image with the bookmark.

Schena et al. is directed to bridging the gap between tangible object media, the virtual world of interactivity and the Internet (Schena, column 2, lines 15-16). Regarding the background of this objective, Schena states as follows. "Until recently, only one company, Network Solutions, Inc. (NSI), was charged with allocating and administering DNS. (column 1, lines 44-45) "The invention described herein provides for an alternative to the present DNS schema by using a system which incorporates scanner technology to manage the DNS." (column 1, lines 51-54) "There exists a need for managing a DNS that can link all users of printed media and tangible object media to the "virtual world" and that can deliver desired information to the user without regard to the user's technical expertise, knowledge of IP addresses or domain names." (column 2, lines 9-13)

To achieve these objectives, Schena discloses the following technology. "The method involves scanning a machine-readable code containing a link information corresponding to the provider information from the object using the scanner and storing the machine-readable code in a memory. The link information is then extracted from the machine readable code in the memory. A user input information corresponding to the provider information is also obtained and stored in the memory. The link information and the user input information are then sent to the portal server via the network. The portal server receives the link information and user input information and selects a multimedia information sequence corresponding to the link information and the user input information. The multimedia information sequence is then sent to the receiver via the network. The receiver receives and stores the multimedia information sequence plays the sequence automatically or in response to a stimulus, such as a user request." (column 2, lines 29-46)

As can be seen from the above citation in the description, Schena is interested in providing a technology on a portal server (column 2, line 38) by collecting the necessary information from a scanner device (column 2, line 32).

The Examiner alleges that it would have been obvious to one of ordinary skill at the time of the invention to have stored the history of scanned links as bookmarks so that a user could recall the collection of stored links for future reference, based on the description, "scanning the codes for immediate or delayed processing or for reference and that the links may be collected, sorted, and prioritized" (Schena, column 10, lines 7-12, 43-47). Applicant contends that while Schena may collect, sort, and prioritize the links, this is not for displaying on the scanner but for the portal server to manage a DNS, according to the above citation. Further, merely collecting codes or links does not create a bookmark; further steps are required. In order

to use the scanned links of Schena as a bookmark, knowledge of additional steps would be required by a user of these links. The user would have to at least identify the links to bookmarking software, provide images and perhaps titles for the links, and store these links as bookmarks along with icons. Schena does not suggest converting the links to bookmarks; Schena also does not suggest displaying the links not only at the time of a scan but also at a later time on the scanner side. Thus, Applicant respectfully disagrees with the Examiner's statement that skill in the art provides one with the ability to create and store bookmarks based on the disclosure of Schena. "Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment." *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In the alternative, the Examiner's rejection as stated on page 2, lines 21-25, can be considered to be anticipation by inherency instead of obviousness. Applicant respectfully traverses this rejection. To support a prima facie case of anticipation by inherency, the limitation in question must "necessarily" be present in the prior art reference. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Applicant respectfully submits that the Examiner has not provided a basis in fact or technical reasoning to support this rejection because Schena alone does not provide teaching or suggestion for converting links into bookmark icons.

Dougherty is directed to improve the human/computer interface by providing printable interfaces that enable a user to invoke and control computer processes (Dougherty,

column 2, lines 53-55). In order to achieve this object, Dougherty adopts Multicon Linkmark icons.

The Examiner alleges that Dougherty teaches scanning physically printed code in a publication whereby scanning the code with an optical scanner directs the user to a website for more information, and cites Figure 10 (Office Action, page 2, line 25, to page 3, line 1). Figure 10 illustrates a Multicon Linkmark which contains a plurality of icons, such as an audio icon, a text icon, a video icon (Dougherty, column 10, line 63 to column 11, line 58). However, no teaching or suggestion is provided regarding how these icons are used or combined to create a bookmark icon. Similar to Schena, applicant believes that a user would need additional knowledge to create a bookmark or bookmark icon from the Multicon Linkmark of Dougherty. As stated above, the skill in the art component will rarely operate to supply missing knowledge or prior art to reach an obviousness judgment. *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

By contrast, Applicant's invention uses an image which is read with a reading element as a bookmark. The present invention not only improves human interface with the bookmark, but also alleviates a burden to create it, which is not recognized by Dougherty at all.

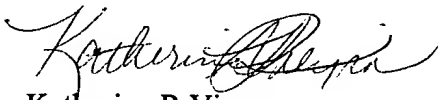
Further, in order to establish a prima facie case of obviousness, there must be some suggestion or motivation to combine the references. See, *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). The absence of such a suggestion to combine is dispositive in an obviousness determination. See, *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 , 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). "The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence." *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 63 USPQ2d 1374

(Fed. Cir. 2002) (Citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). The Examiner has not provided clear and particular evidence to support the combination of these references to establish a prima facie case of obviousness.

As explained above, none of the references cited by the Examiner recognize the advantage of a bookmark as disclosed in the present invention. Therefore, Schena and Dougherty, even taken together in combination, do not disclose or suggest the recitations of independent claims 1 and 6. Further, Claims 3-5 depend from independent claim 1 and claims 7-14 depend from independent claim 6. Thus, claims 3-5 and 7-14 incorporate novel and nonobvious features of their respective base claims and are therefore patentably distinguishable over the prior art for at least the reasons that their respective base claims are patentably distinguishable over the prior art.

For at least the reasons set forth in the foregoing discussion, Applicant believes that the application is now allowable and respectfully requests that the Examiner reconsider the rejections and allow the application. Should the Examiner have any questions regarding this Amendment, or regarding the Application generally, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,



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